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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,054	12/07/2001	Gary A. Ort Merl	14060/249318 (IRC296)	7839
23370	7590	07/02/2004	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET SUITE 2800 ATLANTA, GA 30309			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 07/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/010,054	MERTL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/7/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/16/02, 12/7/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to a spacer, classified in class 428, subclass 304.4.

II. Claims 9-19, drawn to a method for forming a multi-density foam structure, classified in class 264, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case product as claimed can be made by another and materially different process, such as a co-extrusion process.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Geoffrey Gavin on 6/21/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9-19 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

6. New corrected drawings are required in this application because the drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

7. Claim 8 is objected to because of the following informalities:  
In claim 8, line 1, please change the term "are" to --have--.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cascino (US 4806404) in view of Cascino (US 5328937).

The invention of Cascino '404 is directed to a self-adherent spacer member for positioning between fragile objects, such as glass panels, during shipment. The spacer includes a tack (cling) layer of sufficient adhesive properties to allow the spacer to adhere to the surface of the fragile object without the use of a surface tape (Abstract). The spacer of includes a layer of base material bonded directly to a tack layer (column 1, lines 19-20). The tack layer is preferably formed of a foamable polymer material such as foamable polyvinyl chloride, foamable polyurethane, or the like (column 2, lines 2-4). In the Example, Cascino '404 teaches that the tack layer is formed from a foamable polyvinyl chloride plastisol (column 2, lines 20-30), and the tack layer is laminated to a backing layer such as a polyethylene foam cushion layer (column 1, lines 66-68).

For claims 1 and 4-6, Cascino '404 lacks express teachings that the density of the densities of the layers and the backing (second) layer is also a foamed flexible PVC plastisol. However, it is noted that Cascino '937 is directed to a foam spacer which is usable as a cork substitute in the base cushion layer of a glass spacer. The spacer, which is adapted to replace natural cork spacers, is preferably laminated to a tack layer or otherwise adhered to a surface. The spacer is formed from a plasticized foamable resin (Abstract). Further, the foamable resin is preferably a PVC compound and may consist of a single resin or a mixture of resins (column 2, lines 3-4), such as the PVC

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plastisol shown in the Example (column 2, line 49 to column 3, line 3). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute the cushion layer of Cascino '404 with an equivalent cushion layer of Cascino '937, motivated by the desire to use an available equivalent material. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. As to the densities of the layers, it is believed suitable densities are either anticipated by Cascino, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a backing which has adequate strength for the tack layer. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For claims 2 and 3, Cascino '404 expressly teaches that a release paper of conventional composition adjacently overlies tack layer and prevents adhesion of spacer until desired (column 2, lines 13-15). Further, the Examiner notes that a release layer of a silicon-treated, glossy-surfaced carrier sheet is conventional and well known.

For claim 8, Cascino lacks a teaching that the first and second foam layers have different colors. However, the Examiner notes that it is old and common knowledge that the outer surfaces of a multilayered plastic sheet may color coded, so as to provide easy identification to specific layer for use, as evidenced by JP 10109385, which is directed to a multilayered laminate. JP '385 teaches that "to enable easy identification



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of front and rear surfaces and to securely prevent failure of erroneously sticking the front and rear surfaces by entirely or partly coloring at least one surface with color different from that of the other surface." (Abstract). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of a multilayered laminate to color code the outer layers, motivated by the desire to obtain a laminate with easily identifiable outer surfaces (via color code) for use.

10. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cascino (US 4806404) in view of Cascino (US 5328937), or further in view of Lerman (US 3616029).

The teachings of Cascino '404 and Cascino '937 are again relied upon, as set forth above.

For claim 7, Cascino lacks a teaching that the outer surface of the second foam layer is embossed to impart a rough texture. However, the Examiner notes that it is known art that a plastic foam sheet is embossed to provide improved cushioning properties. Alternatively, it is noted that Lerman's invention is directed to a method for forming a resilient pad from a plurality of plastic foam sheet members (Abstract). Lerman teaches that this pattern of depressions (embossed pattern) on the surface of the pad permit the pad to be compressed more than would be possible if there were no depressions (column 3, lines 9-12). As such, it would have been obvious to one of ordinary skill in the art to emboss the outer surface of cushion layer of Cascino '404, motivated by the desire to obtain an improved cushioning property for protecting the fragile glass panels.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER  
PRIMARY EXAMINER  
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1700

*Daniel Zinker*